

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/817,269
Attorney Docket No. Q62636

REMARKS

I. Introduction

The Office Action incorrectly lists claims 1-95 as pending in the application. The application was originally filed on March 27, 2001 with claims 1-87 and 89-94 and without a claim 88 being submitted. A first preliminary amendment, filed concurrently with the application, canceled claim 91 and rewrote claims 89, 90, 92, 93 and 94 as claims 88, 89, 91, 92 and 93, respectively. Thereafter, a second preliminary amendment filed on July 11, 2001 added new claim 95. As an initial matter, Applicant rewrites current claim 91 as claim 90, since claim 91 was previously canceled and since there is not currently a claim 90 in the application. Thus, claim 92 is amended to correct its dependency. Furthermore, since there is not currently a claim 94 in the application, Applicant rewrites current claim 95 as claim 94.

It is respectfully submitted that the aforementioned amendments are intended to further clarify the numbering of the claims in the application and are not being made for purposes of patentability. Applicant's response to the non-final Office Action dated November 2, 2004, as set forth herein, is based on these renumbered claims.

All of the claims pending in the application have been examined. Claims 46-90 and 92-94 are allowed. Furthermore, the Examiner acknowledges that claims 7-26 and 32-45 contain allowable subject matter. Claims 1-6 and 27-31, however, are rejected.

Specifically, claims 1-5 and 27-31 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,584,118 to Russell et al. (hereinafter "Russell") in

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/817,269
Attorney Docket No. Q62636

view of U.S. Patent No. 5,323,392 to Ishii et al. (hereinafter “Ishii”). Claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Russell and Ishii, as applied to claims 1-5 and 27-71, and further in view of U.S. Patent No. 6,804,248 to Tomar et al. (hereinafter “Tomar”).

As noted below, claims 20 and 42 are canceled. Thus, in view of the aforementioned amendments, claims 1-19, 21-41, 43-90 and 92-94 are pending in the application, with claims 20 and 42 being canceled herein and originally filed claim 91 having been previously canceled.

II. Allowable Subject Matter

As noted above, claims 46-90 and 92-94 are allowed.

Furthermore, claims 7-26 and 32-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Office Action: page 8).

Since the rejections of the independent claims are overcome, as set forth below, dependent claims 7, 14-16, 18-19, 21-23, 32 and 38-41 are allowable at least by virtue of their dependency.

Although the Examiner sets forth her reasons for indicating the allowable subject matter (*see* Office Action: pages 8-9), it is respectfully submitted that each of the allowable/allowed claims is patentable, as a whole, based on the entirety of the features recited therein.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/817,269
Attorney Docket No. Q62636

III. Claim Rejections – 35 U.S.C. § 103(a)

As noted above, claims 1-5 and 27-31 stand rejected under § 103(a) as allegedly being unpatentable over Russell in view of Ishii; and claim 6 stands rejected under § 103(a) as allegedly being unpatentable over Russell in view of Ishii, and further in view of Tomar.

Applicant overcomes these grounds of rejection by incorporating the allowable subject matter of claims 20 and 42 into claims 1 and 27, respectively, thereby placing claims 1 and 27 in condition for allowance. Consequently, claims 2-6 and 28-31 are placed in condition for allowance by virtue of their dependency.

IV. Formal Matters

A. Priority

The present application is a CIP of Application No. PCT/CN00/00211 filed on July 26, 2000. The Examiner acknowledges Applicant's claim for priority. The priority document was filed in the parent application (*i.e.*, PCT/CN00/00211).

B. Cited References

The Examiner provides a signed and initialed copy of the Form PTO-1449 submitted with the IDS filed on March 27, 2001, thereby acknowledging consideration of the references cited therein.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/817,269
Attorney Docket No. Q62636

C. Drawings

The Examiner objects to the drawings under 37 CFR 1.83(a) as allegedly failing to show every feature of the invention specified in the claims. In particular, the Examiner alleges taht the drawings fail to show "a fourth process means for converting said second type of frames to a third type of frames corresponding to in said data packets; and a second transmitting means for transmitting the extracted data packets to said upper layer side device," as recited in claim 46, and similarly in claims 70 and 95. It is respectfully submitted that the drawings sufficiently illustrate these features of claims 46, 70 and 95.

For example, claim 9 is directed to an interfacing apparatus of Ethernet over SDH/SONET (Applicant's specification: page 7). The interfacing apparatus includes an RX FIFO unit 13 (Applicant's specification: page 15, lines 6 to page 16, line 4; and Fig. 9). The functions of the RX FIFO unit 13 include, *inter alia*, adapting the rate of LAPS to that of MII (*Id.*). For example, the RX FIFO unit 13 may adapt periodic 155M LAPS frames to parallel burst 100M MII frames, which correspond to the second type of frames and the third type of frames recited in claim 46, as well as in claims 70 and 95 (*Id.*).

Furthermore, another function of the RX FIFO unit 13 is to send the data packets, for example, IP packets (*Id.*). Thus, the RX FIFO unit 30 not only converts the received SDH/SONET frames to MII frames, but also transmits the converted frames to the Ethernet layer via transformer 19, which corresponds to the second transmitting means recited in claim 46, as well as in claims 70 and 95 (Applicant's specification: page 55, lines 12-16; and Figs. 9 and 13).

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/817,269
Attorney Docket No. Q62636

In view of the above, the features noted by the Examiner are sufficiently illustrated in the drawings as required by 37 C.F.R. § 1.83(a). Consequently, Applicant requests that the Examiner withdraw her objection to the drawings.

D. Specification

Applicant amends the specification to correct the typographical errors noted by the Examiner, for example, at page 1, line 6 and page 12, line 30 of the specification.

It is respectfully submitted, however, that the Examiner's request to replace "sSTM" with "STM" at page 12, line 30 of the specification is incorrect. The use of the term "sSTM" was intended by Applicant as evidenced, for example, by its inclusion in the list of abbreviations provided on pages 8-9 of the specification. Consequently, Applicant has not changed this term.

In view of these amendments, it is respectfully submitted that the Examiner's objection to the specification is overcome.

E. Claims

Applicant amends claims 1, 27, 46 and 70 to make the cosmetic changes suggested by the Examiner. Furthermore, the amendments described above in Section I are intended to restore the claims to their condition at time of filing (*i.e.*, including the Preliminary Amendment filed concurrently with the application) and to correct the confusion caused by both canceling original claim 91 and then renumbering another claim as claim 91. In view of these amendments, it is respectfully submitted that the Examiner's objections to the claims are overcome.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/817,269
Attorney Docket No. Q62636

Additionally Applicant amends claims 7, 32, 52 and 76 to correct an inadvertent typographical error therein. In particular, the equation $g(x) = x^7 + 1$ is amended to the correct equation of $g(x) = x^{43} + 1$. Support for these amendments can be found, for example, at page 16, line 13; page 22, line 5; and page 49, line of Applicant's specification.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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